



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/530,615	04/07/2005	Patrice Bujard	II/2-22760/A/PCT	7001
324 7590 09/09/2008				
JoAnn Villamizar				
Ciba Corporation/Patent Department				
540 White Plains Road				
P.O. Box 2005				
Tarrytown, NY 10591				
EXAMINER				
RONESL VICKEY M				
ART UNIT		PAPER NUMBER		
1796				
MAIL DATE		DELIVERY MODE		
09/09/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/530,615

Applicant(s)

BUJARD ET AL.

Examiner

VICKEY RONESI

Art Unit

1796

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 June 2008.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-10 and 16-19 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1,3-10 and 16-19 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-8508)
Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____

DETAILED ACTION

1. All outstanding claims objections and rejections, except for those maintained below, are withdrawn in light of applicant's amendment filed on 6/6/2008.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior office action.
3. No new grounds of rejection are set forth below. Thus, the following action is properly made final.

Claim Rejections - 35 USC § 103

4. Claims 1, 4-7, 10, 17, and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bujard et al (US 5,766,355) in view of Hermann et al (US 6,294,592).

The rejection is adequately set forth in paragraph 4 of Office action mailed on 3/10/2008 and is incorporated here by reference. It is noted that transitional claim language "consisting essentially of" does not exclude the use of a composite core. While it is recognized that the phrase "consisting essentially of" narrows the scope of the claims to the specified materials and those which do not materially affect the basic and novel characteristics of the claimed invention, absent a clear indication of what the basic and novel characteristics are, "consisting essentially of" is construed as equivalent to "comprising". Further, the burden is on the applicant to show that the additional ingredients in the prior art, i.e. an aluminum core coated with $\text{SiO}_{0.25-0.95}$, would in fact be excluded from the claims and that such ingredients would materially change the characteristics of the applicant's invention, See MPEP 2111.03. Case law holds that "[i]f an applicant contends that additional steps or material in the prior art are excluded by the recitation

of 'consisting essentially of,' applicant has the burden of showing that the introduction of additional steps or components would materially change the characteristics of applicant's invention." *In re De Lajarte*, 337 F.2d 870, 143 USPQ 256 (CCPA 1964).

5. Claims 1, 3, 10, and 16 rejected under 35 U.S.C. 103(a) as being unpatentable over Schmid et al (US 5,624,486) in view of Hermann et al (US 6,294,592).

The rejection is adequately set forth in paragraph 5 of Office action mailed on 3/10/2008 and is incorporated here by reference.

Double Patenting

6. Claims 1, 7-9, and 19 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 10 of U.S. Patent No. US 7,223,472 in view of Hermann et al (US 6,294,592).

The rejection is adequately set forth in paragraph 6 of Office action mailed on 3/10/2008 and is incorporated here by reference. It is noted that claim 19 was inadvertently not rejected over US '472 in view of Hermann et al but the discussion in paragraph 6 of Office action mailed on 3/10/2008 clearly encompasses this claim. Note that the Office Action Summary mailed with the Office action on 3/10/2008 indicated that claim 19 stood rejected.

7. Claims 1, 7-9, and 19 are rejected under 35 U.S.C. 103(a) as being obvious over U.S. Patent No. US 7,223,472 in view of Hermann et al (US 6,294,592). See the discussion set forth in paragraph 6 above.

The rejection is adequately set forth in paragraph 8 of Office action mailed on 3/10/2008 and is incorporated here by reference. It is noted that claim 19 was inadvertently not rejected over US '472 in view of Hermann et al but the discussion in paragraph 6 of Office action mailed on 3/10/2008 clearly encompasses this claim. Note that the Office Action Summary mailed with the Office action on 3/10/2008 indicated that claim 19 stood rejected.

Response to Arguments

8. Applicant's arguments filed 6/6/2008 have been fully considered but they are not persuasive. Specifically, applicant argues that Hermann et al discloses that the pigment in the ink composition must be finely divided to be used in an ink-jet process and would dissuade one of ordinary skill in the art to use the pigments of Bujard et al, Schmid et al, and US '472 in an ink-jet ink or process thereof.

In response, while Hermann et al does not disclose all the features of the present claimed invention, it is used as teaching reference, and therefore, it is not necessary for this secondary reference to contain all the features of the presently claimed invention, *In re Nievelt*, 482 F.2d 965, 179 USPQ 224, 226 (CCPA 1973), *In re Keller* 624 F.2d 413, 208 USPQ 871, 881 (CCPA 1981). Rather this reference teaches a certain concept, and in combination with the primary reference, discloses the presently claimed invention. Specifically, Hermann et al is relied upon to disclose that ink jet ink requires a binder and a dispersant like presently claimed. Furthermore, Hermann et al does not teach that pigments with a particle size of greater than 1 micron cannot be used in an ink-jet ink printing process. In fact, it only teaches that the pigment particles are fine, preferably less than 1 micron. It is the examiner's position that the

pigment particle of Bujard et al, Schmid et al, and US '472 are "fine" and would work in an ink-jet printing process, absent evidence to the contrary.

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vickey Ronesi whose telephone number is (571) 272-2701. The examiner can normally be reached on Monday - Friday, 8:30 a.m. - 5:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (571) 272-1119. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

9/2/2008
Vickey Ronesi

/V. R./
Examiner, Art Unit 1796

/Vasu Jagannathan/
Supervisory Patent Examiner, Art Unit 1796